

**REMARKS**Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the attached Declaration of Ms. Soc Man Ho Kimura and the following remarks.

Request for Withdrawal of Finality of the Office Action

Applicants hereby reiterate their Request for Withdrawal of Finality of the outstanding Office Action because it is deemed that the Finality was premature. In accordance with MPEP 706.07(a), a second and subsequent Action on the merits in any Application should not be made Final if it includes a rejection based on newly-cited prior art.

In the outstanding Office Action, the rejection is based on a combination of Arai and Maeda. Both of these were first cited in the May 31, 2006 Office Action. Thus, it is respectfully submitted that the Finality was premature and that it should be withdrawn.

Applicants previously submitted such a Request, however, such Request has not, as yet, been granted. Applicants hereby reassert their Request of Withdrawal of Finality of the outstanding Office Action.

#### Claims Status

Claims 1-4, 6 and 10-13 are presented for further prosecution. No amendments have been made at this time.

#### Rejection

Claims 1-4, 6, 10 and 12 have been rejected as being anticipated by or unpatentable over Arai and Claims 11 and 13 have been rejected as being unpatentable over a combination of Arai and Maeda. In the Office Action, the Examiner took the position that Arai inherently teaches the ratio  $SB/SA \leq 0.2$ . The Examiner also took the position that the electron trapping dopant, 4-hydroxy-6-methyl-1,3,3a,7-tetrazaindene, as used in Example 3 of Arai, was present on the inside of the silver halide grains.

In order to refute the Examiner's position of inherency and physical location of the grains, tests have been performed and those results are reported by the Declaration of Ms. Soc Man Ho Kimura. As can be seen by the Declaration, Ms. Kimura prepared

the material of Example 3 of Arai. She then went on to test the material to demonstrate that it had an SB/SA ratio outside the claimed range. In fact, as can be seen in Table 6 attached to the Declaration, the ratio SB/SA was 0.29. As the Examiner will appreciate, the claims recite that the SB/SA ratio must be  $\leq$  0.2.

Furthermore, Ms. Kimura noted that the location of the dopant in the material prepared in accordance with Example 3 of Arai is outside the silver halide grains and is not added at nuclear formation or during grain growth.

Respectfully, in light of the Declaration data presented herein, Applicants have refuted the Examiner's prima facie case of inherency and shown that Arai does not meet the claimed limitations.

Turning to the secondary reference, Maeda, Maeda does not teach nor suggest the element missing by Arai and, therefore, the combination of Maeda and Arai does not teach nor suggest the Invention as claimed.

In view of the foregoing, it is respectfully submitted that the claims of the instant Application are patentable over either one of the cited references taken alone or in combination.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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DCL/mr

Encl: Executed Declaration of Ms. Soc Man Ho Kimura signed on  
July 7, 2006